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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,065	11/12/2004	Hiroto Nakamura	2593-0149PUS1	8592
2292 7590 03/25/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER NGUYEN, TRUNG Q				
ART UNIT 2829		PAPER NUMBER		
NOTIFICATION DATE 03/25/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/512,065

Applicant(s)

NAKAMURA, HIROTO

Examiner

TRUNG Q. NGUYEN

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2829

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-10 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Tsutsumi et al. (U.S. 5,629,632).

Tsutsumi et al. disclose in Fig. 1, an electronic device testing apparatus (Figs 1-2) for conducting a test by pressing via push mechanism 24 (column 5, lines 52-65) and moving means (column 5, lines 45-51) comprising test head 20-21 on an electronic device conveying medium via conveying tray 11 (column 4, lines 35-50), a plurality of contact groups 18A and 19A (column 4, lines 10-30); and a moving means capable of independently controlling electronic device conveying medium loaded with electronic devices to be tested to contacts (column 4, lines 35-65). Tsutsumi et al. also disclosed in Figs. 15 an electronic device conveying medium 11A-11D loaded with electronic devices D to be tested is a strip format (DUT D arranged in columns and rows as seen in Fig. 1).

Allowable Subject Matter

3. Claims 3-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: claims 3-10 recite, inter alia, "a control means for finishing tests with the shortest time on remaining electronic devices to be tested on electronic device conveying medium when a lot of electronic devices to be tested finishes." The art of record does not disclose the above limitations, nor would it be obvious to modify the art of record so as to include the above limitations.

Response to Arguments

4. Applicant's arguments with respect to claim 1 have been considered. However, the arguments are not persuasive.

The applicants argue that: Tsutsumi et al. Does not disclose contact group and a plurality of moving means which is capable of moving strip format.

The examiner respectfully disagrees to the above argues because: Tsutsumi et al. disclose a plurality of contact groups 18A and 19A (column 4, lines 10-30) and the individual devices are separately moved to be tested in which equivalent to the term "plurality of moving means" as described in claim 1. However, the features upon which applicant relies (i.e. The entire strip format is moved together with the electronic devices) are not recited in the rejected claim(s). Although the claims are interpreted in

light of the specification, limitations from the specification are not read into the claims.

See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

5. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within two months of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Trung Nguyen** whose telephone number is **(571) 272-1966**. The examiner can normally be reached on **Monday through Friday, 8:30AM –**

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4:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ha Nguyen** can be reached at (571) 272-1678.

Trung Nguyen
Patent Examiner
Group Art Unit 2829
March 14, 2008.

/Ha T. Nguyen/

Supervisory Patent Examiner, Art Unit 2829

Application Number**Application/Control No.**

10/512,065

Examiner

TRUNG Q. NGUYEN

**Applicant(s)/Patent under
Reexamination**

NAKAMURA, HIROTO

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